

REMARKS

Currently, claims 1-26 are pending. In the response to the previous Office Action mailed October 4, 2002, claims 2, 10, and 16 were amended and claims 24-26 were added. In regards to the response to the previous Office Action, this Office Action states that Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of new grounds of rejection.

Claims Rejections

35 USC §103(a) Rejections

Claims 1-8 and 15-20 are rejected by the Office Action under 35 USC §103(a) as being unpatentable over Shaffer (U.S. Patent No. 5,901,214) in view of Mankovitz (U.S. Patent No. 6,253,069). As asserted by the Office Action, Shaffer (col. 28, lines 19-32) teaches "providing the requested information to the caller in accordance with the request." As admitted by the Office Action, "Shaffer fails to disclose credit history information." The Office Action further asserts:

However, Mankovitz teaches an apparatus for providing credit history information for a customer (column 7, lines 25-42).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to add credit history information of Mankovitz in the invention of Shaffer.

The modification of the invention would offer the capability of having credit history information such as a user would be able to access information on a customer.

However, as stated in MPEP §2141, "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." (Emphasis added.) Applicant submits that the Office Action is using what is claimed in the claimed invention of claim 1, and not what is taught or suggested in the prior art, in order to provide motivation to combine prior art references in order to form the patentee's claimed invention. Thus, in regard to claim 1, Applicant submits that the Office Action has not provided *prima facie* obviousness because the Office Action

has not shown suggestion or motivation. Claims 2-8 and 24 dependent from claim 1. Thus, for at least the same reasons, Applicant submits that claims 2-8 are patentable over Shaffer in view of Mankovitz. Moreover, regarding claims 3 and 17, Applicant further submits that Shaffer, as referenced by column 23, lines 35-54, does not teach or even suggest "the gateway terminal has a security checker for ensuring access to the searchable database by authorized callers." Shaffer teaches (col. 23, lines 35-54):

Individual Databases Indexed by Individual ID (Social Security Number) (114, FIG. 1)

There are three major individual databases 114 that are indexed by social security number: TRW, Equifax and TransUnion (TU). The preferred database is the TU database. Once an individual's social security number has been retrieved from above (database 112), it is a basic process to use the social security number as a means of retrieving credit and public record data associated with the social security number from the TU database.

Polk and some states provide access into their driver license databases based on knowing a driver's license number. Again, once this is retrieved from database 112 above, it is a basic process to access this data. This data contains driving history, and in some cases, linkage to vehicle registration data. An automobile make and model associated with the household and individuals can be retrieved from the vehicle registration data.

Applicant submits that Schaffer does not teach or even suggest the feature "wherein the gateway terminal further has a **security checker** for ensuring access to the searchable database **by authorized callers**". (Emphasis added.) Regarding claims 4 and 18, Applicant further submits that Shaffer, as referenced by column 3, lines 16-31, does not teach "converting the **digits** into at least one American Standard Code for Information Interchange (ASCII) character." (Emphasis added.) Shaffer, as cited, teaches:

There is also primitive technology available to scan and translate video images **in the form of hand-written messages and typed characters, words, and sentences** into digital data, such as the ASCII character set. (Emphasis added.)

Thus, Applicant requests for reconsideration of claims 2-8.

Regarding claim 15, the Office Action admits that "Shaffer fails to disclose the address information."

The Office Action further asserts that:

However, Mankovitz teaches an apparatus for providing the address information for a customer (column 6, lines 31-41).

It would have been obvious to one of the ordinary skill at the time the invention was made to address the address information of Mankovitz in the invention of Shaffer.

The modification of the invention would offer the capability of having the address information such as the user would be able to locate the user would be able to locate the customer.

However, as stated in MPEP §2141, “The references must be viewed without the benefit of impermissible hindsight vision afforded **by the claimed invention.**” (Emphasis added.) Applicant submits that the Office Action is using what is claimed in the claimed invention of claim 15, and not what is taught or suggested in the prior art, in order to provide motivation to combine prior art references in order to form the patentee’s claimed invention. Thus, in regard to claim 15, Applicant submits that the Office Action has not provided *prima facie* obviousness because the Office Action has not shown suggestion or motivation. Because claims 16-20 depend from claim 15, Applicant submits that claims 16-20 and 26 are patentable for at least the above reasons. Thus, Applicant requests for reconsideration of claims 15-20.

Claims 9-14 are rejected under 35 USC §103(a) as being unpatentable over Shaffer in view of Lowery (U.S. Patent No. 6,446,111). The Office Action presents the motivation for combining Shaffer and Lowery by the following:

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to add the book availability information of Lowery in the invention of Shaffer.

The modification of the invention would offer the capacity of having a book availability information data such as the user would search for the book authors.

However, as stated in MPEP §2141, “The references must be viewed without the benefit of impermissible hindsight vision afforded **by the claimed invention.**” (Emphasis added.) Applicant submits that the Office Action is using what is claimed in the claimed invention of claim 9, and not

what is taught or suggested in the prior art, in order to provide motivation to combine prior art references in order to form the patentee's claimed invention. Thus, in regard to claim 9, Applicant submits that the Office Action has not provided *prima facie* obviousness because the Examiner has not shown suggestion or motivation. Thus, Applicant requests for reconsideration of claim 9. Claims 10-14 depend from independent claim 9. For at least the same reasons as claim 9, Applicant submits that claims 10-14 are patentable over Shaffer in view of Lowry. Moreover, regarding claim 11, Applicant further submits that Shaffer, as cited at column 23, lines 35-54, does not teach or even suggest that "the gateway terminal has a security checker for ensuring access to the searchable database by authorized callers" for the reasons as discussed for claims 3 and 17. Regarding claim 12, Applicant further submits that Shaffer, as cited at column 3, lines 16-31, does not teach "converting the digits into at least one American Standard Code for Information Interchange (ASCII) character" for the reasons as previously discussed for claim 4. Thus, Applicant requests reconsideration of claims 9-14.

Claims 21-23 are rejected under 35 USC §103(a) as being unpatentable over Shaffer in view of Mankovitz and in further view of Lowery. Regarding claims 21 and 22, as admitted by the Office Action, "Shaffer fails to disclose the credit history information and the address information." However, for the reasons previously presented in combining Mankovitz with Shaffer and combining Lowery with Shaffer, Applicant submits that the Office Action has not provided *prima facie* obviousness because the Office Action has not shown suggestion or motivation. Claim 23 depends from claim 22. Thus, Applicant requests for reconsideration of claims 21-23.

Claims 24 and 26 are rejected by the Office Action as being unpatentable over Shaffer in view of Mankovitz and in further view of Drugos (U.S. Patent No. 4,135,662). Because claims 24

and 26 are dependent upon claims 1 and 15, respectively, Applicant requests for reconsideration for the above reasons.

Claim 25 is rejected under 35 USC §103(a) as being unpatentable over Shaffer in view of Lowery and in further view of Dlugos. Because claim 25 depends from claim 9, Applicant requests for reconsideration for the above reasons.

All objections and rejections having been addressed. Hence, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

Respectfully submitted,

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